

R E M A R K S

Prior to entry of this Amendment:

- Claims 1-67 were pending in the present application
- Claims 1-67 stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 1-54 and 57-74 will be pending (72 claims total)
- Claims 1, 23, 44, 49-54, 57-61, 63-65, 67, and 72 will be the only independent claims (19 independent claims)
- Claims 45-58, 60, and 63 will be amended
- Claims 68-74 will be added
- Claims 55 and 56 will be cancelled

Telephone Interview

Applicants would like to thank the Examiner for the helpful telephone conversation held on December 4, 2003, with Applicants' representative.

The Examiner and Applicants' representative discussed the present application in light of the Kolls reference. Applicants' representative suggested that Kolls does not teach or suggest features generally directed to gambling, gaming machines (e.g., slot machines), or play of gaming machines (or players of gaming machines).

Applicants are grateful for the Examiner's acknowledgement during the Interview that all of Claims 1-54 and 57-67 produce a useful, concrete, and tangible result.

Applicants are also grateful for the Examiner's statement that Claims 1-54 and 57-66 appeared to satisfy the requirements of Section 101 and that the Section 101 rejection of Claims 1-54 and 57-66 would not be upheld. [Applicants note briefly that the Examiner's Interview Summary mailed December 10, 2003, inadvertently stated that the "101 rejection requirements" were "satisfied" (emphasis added).]

The Examiner stated that Claims 55 and 56 do not meet the concrete, useful and tangible requirements of Section 101. The Examiner also stated that Claim 67 does not meet the requirements of Section 101 because of "lack of technology."

Applicants' representative stated that Claims 45-48, as filed, were mistakenly dependent from Claim 42, and that correction of this error would serve to overcome the Examiner's Section 112 rejection of Claims 45 and 46.

While no formal agreement was reached, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Claim Amendments

1. **Claims 45-58 and 60 have been amended to correct minor typographical errors**

No new matter has been added. Upon review of the Examiner's Section 112 rejection, Applicants became aware that there were obvious errors in Claims 45-58. In each of Claims 45-58, the preamble has been amended so that the claims depend correctly from independent system Claim 42.

Based on an error noted by the Examiner, Claim 60 has also been corrected to recite *a compensation dispensing machine* (emphasis added).

2. **Claim 63**

Independent Claim 63 has been amended to recite *receiving, by a player, a marketing question*. No new matter has been added by this amendment, which is discussed further below with respect to the Section 102(e)/103(a) rejections. Applicants respectfully submit that Claim 63 contains allowable subject matter.

3. **Claims 55 and 56 have been cancelled without prejudice**

Claims 55 and 56 have been cancelled without prejudice. Applicants reserve the right to pursue the subject matter of Claims 55 and 56 in a continuing application.

Section 101 Rejection

The Office Action indicates that Claims 1-43, 51-54, and 57-67 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. [Office Action, page 2]. Applicants respectfully traverse the assertions in the Office Action.

However, the Examiner stated during the Telephone Interview that the Section 101 rejection of Claims 1-43, 51-54, and 57-66 would not be upheld, and the Examiner agreed that those claims meet all of the requirements of Section 101. Applicants are grateful for the Examiner's acknowledgement that Claims 1-43, 51-54, and 57-66 are directed to statutory subject matter.

Applicants respectfully traverse the Examiner's assertion that Claim 67 does not meet the requirements of Section 101 because it "appears to lack such technology." [See Examiner's Interview Summary mailed December 10, 2003]. Clearly, Claim 67 produces the useful, concrete, and tangible result of *providing compensation to a player*. Thus, Claim 67 satisfies the only requirement for statutory subject matter under Section 101. In addition, Claim 67 generally recites *receiving said responses to said marketing question from a controller* (emphasis added), and is thus clearly directed to more than a mere abstract idea.

During the Telephone Interview, the Examiner stated that Claims 55 and 56 "would not meet the concrete, useful and tangible requirements of 101." Applicants respectfully traverse this assertion. Claims 55 and 56 each clearly produce the useful, concrete and tangible result of

distributing compensation to a player. However, Claims 55 and 56 have been cancelled solely in order to expedite allowance of the present application.

Section 112 Rejection

Claims 45 and 46 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner notes insufficient antecedent basis in the claims for “the network.” Upon entry of this amendment, the dependencies of all of Claims 45-48 will be corrected to depend correctly on system Claim 42, which recites a feature of *a network coupled to said server*. Applicants are grateful for the Examiner’s notice of this error. Applicants respectfully submit that Claims 45-48 are in condition for allowance.

During the Telephone Interview, the Examiner noted that there is insufficient basis for “said compensation dispensing machine” of Claim 60. [See Examiner’s Interview Summary mailed December 10, 2003]. Applicants are grateful the Examiner’s notice of this error, which has been corrected by this Amendment. Applicants respectfully submit that Claim 60 is in condition for allowance.

Section 102(e) and Section 103(a) Rejections

Claims 1, 2, 4, 5, 10-27, 29-41, 43, 49-67 stand rejected under either 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,615,183 issued to Kolls (“Kolls”) or under 35 U.S.C. 103(a) as being obvious over Kolls. Claims 3, 6-9, 28, 42, and 44-48 stand rejected under 35 U.S.C. 103(a) as being obvious over Kolls and in light of the Examiner’s Official Notice. Applicants respectfully traverse the Examiner’s Section 102(e) and Section 103(a) rejections.

Various embodiments of the present invention are directed to systems and methods for gathering marketing information from a player. For example, a market can transmit marketing questions to a slot server that can be coupled to one or more slot machines. The slot machines can dispense compensation to a player at a slot machine for answering marketing questions. [See, e.g., Specification, page 4, lines 16-26].

Applicants respectfully note, however, that the Examiner’s rejection is devoid of any mention of a player. Kolls, which forms the basis for all of the Examiner’s rejections, is devoid of any hint or suggestion of games or gaming machines, much less *a player*—the Examiner does not assert otherwise. The Examiner refers only to “a user” or “customer” of the Kolls system. The Examiner does not even assert, however, that a “user” or “customer” of the Kolls system suggests *a player*. Applicants respectfully submit that the Kolls reference does not suggest any interaction of the described system with *a player*.

The Examiner also does not provide any argument or indication as to why it would have been obvious to modify the Kolls system in order to provide for steps related to a player, nor does the Examiner cite any reference teaching or suggesting *a player*.

Thus, the Examiner does not establish any support in the evidence of record for any of the features of transmitting a marketing question to a player, receiving a response to a marketing

question from a player, or compensating a player, as generally recited in independent Claim 1. All of independent Claims 23, 44, 49-54, 57-61, 64, 65, and 67 also recite a feature of *a player*. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent Claims 1, 23, 44, 49-61, 64, 65, and 67.

Independent Claim 63 has been amended and now recites a feature of *receiving, by a player, a marketing question* (emphasis added).

Accordingly, Applicants respectfully submit that all of the independent claims (Claims 1, 23, 44, 49-54, 57-61, 63-65, and 67) contain allowable subject matter. Accordingly, Applicants respectfully request allowance of pending Claims 1-54 and 57-67.

Newly-Added Claims 68-74 Are Patentable Over Kolls

Newly-added Claims 68-74 are patentable over Kolls for at least the reasons presented herein.

As discussed above, Kolls is devoid of any hint of a player or a gaming machine. All of new Claims 68-71 are dependent from Claim 1 and are believed to contain allowable subject matter for at least the reasons stated herein with respect to Claim 1. Further, as Kolls is devoid of any hint of a player, games, play of a game, gambling, reels, or gaming machines (e.g., slot machines), Applicants respectfully submit that Kolls is devoid of any hint of any of the features of:

- *a time when the player is losing*
- *a time when a reel is spinning*

as recited in new Claim 68;

- *in which the player has a losing gambling history*

as recited in new Claim 69;

- *wherein said compensation comprises at least one of:
compensation to offset a gambling loss;
an erasure of a gambling loss;
participation in a skill or chance game;
a gambling token;
an increase in odds of winning;
an increased prize table;
an insurance protection against a loss;
an ability to play a higher denomination currency gaming machine for a lower denomination currency;
a free use of an extra slot in a multi-slot slot machine;
an ability to play for free;
an ability to have winnings rounded up to a higher level; and
an auxiliary benefit comprising at least one of:
a free room, and
a subsidized room*

as recited in new Claim 70; and

- *wherein said compensation dispensing machine comprises at least one of:
a slot machine; and
a gaming machine*

as recited in new Claim 71.

Applicants respectfully submit that Kolls does not teach or suggest the method of new independent Claim 72, comprising:

receiving player information about a player;
determining a marketing question based on the player information;
transmitting the marketing question to the player, the player being proximate in space to a gaming machine;
receiving a response of the player to the marketing question; and
transmitting to the gaming machine a signal operable to instruct the gaming machine to provide monetary compensation to the player.

Similarly, Kolls is devoid of any hint or suggestion of:

- *transmitting to the gaming machine a signal operable to place an advertising logo on a payline of the gaming machine*

as recited in new Claim 73;

- *retroactively activating a payline of the gaming machine in exchange for gambling plays*

as recited in new Claim 74. Claims 73 and 74 depend from new independent Claim 72.

Applicants respectfully request allowance of new Claims 68-74.

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.


Petition for Extension of Time to Respond

Applicants hereby petition for a one-month extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

January 14, 2004
Date


Michael Downs
Attorney for Applicants
Registration No. 50,252
Walker Digital, LLC
mdowns@walkerdigital.com
(203) 461-7292 /voice
(203) 461-7300 /fax